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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY W. GENSKE,
WILLIAM G. SWINTON,
DAVID VOGEL, PHILIPPE R. KAHN
and ERIC O. BODNAR

Appeal 2009-011309
Application 09/847,811
Technology Center 2400

Before JOSEPH F. RUGGIERO, ALLEN R. MacDONALD and CARLA M. KRIVAK, Administrative Patent Judges.

MacDONALD, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-87. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary independent claim 1 under appeal reads as follows:

> 1. In a computer environment where devices are occasionally connected together, a method for automated transmission and execution of an executable file of interest originating from a digital camera, upon the digital camera's connection to a cellular phone, the method comprising:
>
> connecting the digital camera to a cellular phone capable of hosting the camera;
>
> identifying at least one particular cellular phone that is connected to the camera, including determining communication information allowing communication between the camera and the particular cellular phone, and determining command information allowing the camera to invoke execution of a file of interest at the particular cellular phone;
>
> based on said determined communication information, transmitting the executable file of interest from said camera to the particular cellular phone; and
>
> based on said determined command information, invoking execution of the executable file of interest after it has been transmitted to the particular cellular phone.

Rejections on Appeal

1. The Examiner rejected claims 1-26, 30, 32, 34, and 36-67 under 35 U.S.C. § 102(e) as being anticipated by Robinson (US 6,442,625 B1).

2. The Examiner rejected claims 27-29, 31, 33, 35, and 68-87 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Robinson and Donner (US 2006/0173781 A1).

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting the claims because "the information Robinson transmits cannot reasonably be described as 'an executable file'" as is required by the claims. (App. Br. 8).

2. Appellants also argue "an executable file is one containing instructions to control the operation of a programmable processor and cause the processor to perform certain functions." (App. Br. 9).

Issues on Appeal

Did the Examiner err in rejecting claims 1-87 because Robinson fails to disclose the argued claim limitation?

ANALYSIS

Although we disagree with Appellants' above contention 2, we agree with the Appellants' above contention 1.

Appellants' argued definition of "executable file" is simply not applicable here where Appellants have already set forth a specific definition of this term in their Specification as filed. An executable file is a file "which contains program commands in an executable format." (Spec. 24:26-27) (emphasis added).

Appellants' Specification also states that the injected (transmitted) object is "an executable file (or capable of triggering execution of a corresponding executable file)." (Spec. 39:18-19). Appellants' claims are limited to the "executable file" version of the transmitted object. The second unclaimed version of the transmitted object is not executable; rather, it merely triggers the execution of an executable file. It is clear from Appellants' Specification that a transmitted command can take one of plural formats.

Robinson's patent is silent as to the particular format being used for Robinson's command. Given this silence in Robinson, it might be obvious to implement Robinson's command in any specific prior art format, but it cannot be argued that Robinson's silence anticipates a specific claimed command format when there are plural command formats among which to select.

The Examiner has erred in finding that Robinson describes an "executable file" as required by the claims.

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 1-26, 30, 32, 34, and 36-67 as being anticipated under 35 U.S.C. § 102(e).

(2) Appellants have established that the Examiner erred in rejecting claims 27-29, 31, 33, 35, and 68-87 as being anticipated under 35 U.S.C. § 103(a).

(3) On this record, claims 1-87 have not been shown to be unpatentable.

DECISION

The Examiner's rejections of claims 1-87 are reversed.

REVERSED

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